



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/131,710	08/10/98	PAZ-PUJALT	G 78137RLD

001333
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IM71/0706

EXAMINER

GRENDZYNSKI, M

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 07/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.

09/131,710

Applicant(s)

Paz-Pujalt et al.

Examiner

Grendzynski, Michael E.

Art Unit

1774



– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

THE REPLY FILED Dec 28, 2000 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☐ they raise the issue of new matter. (See NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

4. ☐ Applicant's reply has overcome the following rejection(s): _____
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
see attached sheet
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 1 and 2
9. ☐ The proposed drawing correction filed on _____ a) ☒ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
11. ☐ Other: _____

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DETAILED ACTION

Response to Arguments

1. Applicants try to distinguish the claimed invention from the prior art because the article of the instant invention comprises, in order, (1) a support, (2) an image-receiving layer and (3) a hydrophilic (water-absorbing layer). This argument is not understood. Claim 1 reads an article wherein the uppermost layer comprises a hydrophobic layer. As such, Applicants arguments are not commensurate in scope with the claims.

Applicants further argue that the broad definition "recorded information" adopted by the office is incorrect. It is important to note that the examiner can not read limitations of the specification into the claims. As such, the examiner is giving the phrase "recorded information" its reasonable, broadest interpretation, as explained in Paper No. 13. Applicants argue that the non-pigment portions of the Bodager ink solution are not permanent, thus do not meet the metes and bounds of the claims. Applicants arguments, however, are not commensurate in scope with the claims. Applicants are not claiming a recorded information that is permanent. Additionally, since the Bodager ink comprises dyes which may or may not react with the upper layer (*see col 8, ll 4-12*), and since it is reasonable to conclude that not all the pigments of the ink will be impeded by the uppermost layer, that the Bodager water-absorbing layer contains color from the Bodager ink solution. Applicants further argue that the only component entering the middle layer of Bodager is water. Assuming, *arguendo*, this is the scenario, Applicants' limitation "recorded information" is broad enough to encompass this, since water will affect optical properties such as reflection of light, whether or not such a change is permanent.

**BRUCE H. HESS
PRIMARY EXAMINER**

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Conclusion

2. Should you have any questions concerning this communication, please direct them to Michael E. Grendzynski at telephone number (703) 305-0593. The examiner can be reached at this number from 7:00 a.m. to 3:30 p.m. Monday-Friday. If attempts to reach the examiner by telephone prove unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached at (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

A facsimile center has been established for Group 1700 on the 8th floor of Crystal Plaza 3. The hours of operation are Monday through Friday, 8:45 am to 4:45 pm. The fax numbers for Art Unit 1774 are (703) 305-3599 for official after final faxes, and (703)305-5408 for all other official faxes. Use of the Group 1700 center will facilitate rapid delivery of materials to examiners in Art Unit 1774.

Any inquiry of a general nature, or those relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-2351.



Michael E. Grendzynski
Assistant Examiner
June 20, 2001



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